



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,517	02/11/2005	Masao Morimoto	TIP-05-1008	1151
35811 7590 08/20/2008 IP GROUP OF DLA PIPER US LLP ONE LIBERTY PLACE 1650 MARKET ST, SUITE 4900 PHILADELPHIA, PA 19103				
EXAMINER				
LEESER, ERICH A				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
08/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,517

Applicant(s)

MORIMOTO ET AL.

Examiner

Erich A. Leeser

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 9, 15, 19-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 8, 10-14, 16-18, 22 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to Applicant's correspondence dated June 4, 2008. Claims 1, 3, 4-6, and 8-24 are currently pending and under examination.

Claim Rejections - 35 USC § 112

Examiner previously rejected claims 8, 10-11 and 16 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

- (a) Based on Applicant's claim amendments, Examiner withdraws this rejection.
- (b) Based on Applicant's claim amendments, Examiner withdraws this rejection.
- (c) Based on Applicant's claim amendments, Examiner withdraws this rejection.

Claim Rejections 35 U.S.C. § 103

Examiner previously rejected claims 1, 3, 5-6, 21 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Wu, et al., U.S. Patent Publication 2003/208074.

Applicant argues that the claims should now be allowable because Applicant has amended the claims to include the "optically active" limitation of cancelled claim 7 into independent claim 1.

Upon further consideration, Examiner has concluded that such a limitation does not in fact overcome Wu, et al. as the alkyl-piperazine reactant and product of the reference are both optically active.

In addition, Examiner now expands the rejection to include claims 19-20 as well because the reference teaches the distillation step of claim 19 (2).

Examiner previously rejected claims 1 and 3-6 under 35 U.S.C. § 103(a) as being unpatentable over Kim, et al., *N-Benzyloxycarbonyl-2-methylaminothiazoline as a Selective Benzyloxycarbonylating Reagent of Amines*, Bull. Korean Chem. Soc., Vol. 24, No. 2, 157-58 (2003).

Applicant argues that the claims should now be allowable because Applicant has amended the claims to include the “optically active” limitation of cancelled claim 7 into independent claim 1.

Upon further consideration, Examiner has concluded that such a limitation does not in fact overcome Kim, et al. as the alkyl-piperazine reactant and product of the reference are both optically active.

New Grounds of Rejection

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The following apply.

(a) In claim 9, what solvent does Applicant intend the reaction to take place in? The claim is unclear because the pKa of the compound would vary depending on the solvent used in the reaction. Clarification is required.

(b) In claim 15, the term "hydrous" is unclear. Which alcohols are hydrous and which are not? Clarification is required.

Claim Objections

Claims 8, 10-14, 16-18, 22 and 24 are objected to as being dependent upon rejected independent claims 1 and 21, but would be allowable if rewritten in independent form.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Erich A. Leeser whose telephone number is 571-272-9932. The Examiner can normally be reached Monday through Friday from 8:30 to 6:00 EST.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. James O. Wilson can be reached at 571-272-0661. The fax number for the organization where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erich A. Leeser/

**/James O. Wilson/
Supervisory Patent Examiner, Art Unit 1624**

Erich A. Leeser
Patent Examiner, Art Unit 1624
United States Patent and Trademark Office
400 Dulany Street, Remsen 5C11
Alexandria, VA 22314-5774
Tel. No.: (571) 272-9932

James O. Wilson
Supervisory Primary Examiner, Art Unit 1624
United States Patent and Trademark Office
400 Dulany Street, Remsen 5A11
Alexandria, VA 22314-5774
Tel. No.: (571) 272-0661